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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,790	08/28/2003	Zuyin Yang	021238-577	5605
21839	7590	02/17/2006	EXAMINER	
<b>BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER &amp; MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404</b>				MAYES, DIONNE WALLS
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/649,790	YANG, ZUYIN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dionne Walls Mayes	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 December 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) 3-11 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group II, claims 1-11, in the reply filed on 12/12/2005 is acknowledged. The traversal is on the ground(s) that an examination of the remaining claims can be carried out without undue burden on the examiner. This is not found persuasive because Applicant has failed to rebut the prima facie showing of an undue burden since Applicant has failed to provide an appropriate showing or evidence to rebut the prima facie showing of serious burden set forth in the restriction requirement as is required by MPEP 803. The requirement is still deemed proper and is therefore made FINAL. Claims 12-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US. Pat. No. 6,053,505).

Adams et al discloses nearly all that is recited in the claims since it teaches a system for heating a cigarette which comprises a cigarette and a lighter. The lighter includes a housing into which the cigarette is inserted and a heater inside the housing is

positioned in thermal proximity to the cigarette. A preferred embodiment includes, as the means for heating the cigarette, a inductor in the form of a piece of magnetically susceptible material (corresponding to the claimed "heater element being magnetic") placed external (which would obviously suggest "permanently") to the cigarette, which receives electromagnetic energy from a susceptor coil (corresponding to the claimed "electromagnet"), warms up, and thereby transfers heat to the tobacco portion of the cigarette (see abstract; col. 6, lines 32-41). Although Adams et al may not specifically state that the susceptor coil is actuatable to selectively repulse or attract the heater, claims directed to apparatus must be distinguished from the prior art in terms of *structure* rather than *function*. (Emphasis added) *In re Danly*, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525,1528 (fed. Cir. 1990). See MPEP 2114. Therefore, this limitation is not considered to limit the claims "structurally" and, therefore, does not patentably distinguish the claims from the Adams disclosure. Further, even if one could argue that the limitation articulates "structure", it follows that since the structure of the Adams system is the same as that which is claimed, the susceptor coil of the Adams device would be "capable of" being actuatable to selectively repulse or attract the heater.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al (US. Pat. No. 5,613,505).

Campbell et al discloses nearly all that is recited in the claim since it teaches an inductive heating system for smoking articles, said system including an induction

heating source (corresponding to the claimed “lighter”) to provide an electromagnetic field, via wire coil, which inductively heats pole pieces, made of magnetic material, (corresponding to the claimed “heater element being magnetic”) in thermal proximity with the tobacco rod portion of an inserted cigarette (See entire document). Although Campbell et al may not specifically state that the susceptor coil is actuatable to selectively repulse or attract the heater, claims directed to apparatus must be distinguished from the prior art in terms of *structure* rather than *function*. (Emphasis added) *In re Danly*, 120 USPQ 528, 531 (CCPA 1959). “Apparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525,1528 (fed. Cir. 1990). See MPEP 2114. Therefore, this limitation is not considered to limit the claims “structurally” and, therefore, does not patentably distinguish the claims from the Campbell et al disclosure. Further, even if one could argue that the limitation articulates “structure”, it follows that since the structure of the Campbell et al system is the same as that which is claimed, the susceptor coil of the Campbell et al device would be “capable of” being actuatable to selectively repulse or attract the heater.

***Allowable Subject Matter***

4. Claims 3-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dionne Walls Mayes  
Primary Examiner  
Art Unit 1731

February 15, 2006